

TRADEMARKS

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Legislation

Ghana

Trademarks, by value, are currently the most infringed intellectual property on the Ghanaian market. Recognizing the importance of trademarks and the health and safety risks often implicated in their infringement, the government passed the Trademarks Act, 2004 (Trademarks Act) to bring Ghana into compliance with the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) and to strengthen trademark protection in Ghana. Applicants should be aware that the regulations implementing the Trademarks Act have only recently been drafted and as of April 2011 had not yet been submitted to Parliament. Applicants are advised to inquire of legal counsel as to the current status of the regulations.

Registration of a trademark by a rights-holder confers an exclusive use of the trademark on that rights-holder. The registration of a trademark is valid for a period of ten years from the filing date of the application for registration. The registration may be renewed for consecutive periods of ten years on payment of a renewal fee, and as long as the fees are paid the trademark can exist in perpetuity, provided that it is still in use in The Republic of Ghana.

Violations under the Trademarks Act are punishable by a fine not exceeding 500 penalty units (currently a penalty unit is equal to GHC 12.00; the current maximum fine is GHC 6,000.00) or up to one year imprisonment or to both. A prosecution under the Trademarks Act must commence either three years from commission of the offense, or one year after first discovery of the offense by the prosecutor, whichever occurs first.

International

Ghana is a member of or has ratified the following international agreements regarding trademarks:

- [The Convention Establishing the World Intellectual Property Organization \(WIPO\);](#)
- [The Paris Convention for the Protection of Industrial Property \(Paris Convention\);](#)

- [The World Trade Organization \(WTO\) Agreement on Trade-Related Aspects of Intellectual Property rights \(TRIPS\);](#)
- [The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks \(Madrid Protocol\);](#) and
- [The African Regional Intellectual Property Organization \(ARIPO\).](#)

Under the Paris Convention, an applicant may claim priority of a mark if it is either a state party to the Convention or a member of the WTO. Ghana is party to the Madrid Protocol since September 16, 2008, but Ghanaian law has not been amended to reflect the provisions of the Madrid Protocol. Ghana has signed the Singapore Treaty on the Law of Trademarks, but has not yet ratified it or implemented any laws to reflect its provisions.

Coverage – What Does Trademark Law Protect?

What Can be Trademarked?

The Trademarks Act protects both trademarks and collective marks. A trademark is defined as a sign or combination of signs capable of distinguishing the goods or services of one undertaking from the goods or services of any other undertakings including words such as personal names, letters, numerals and figurative elements. A collective mark is defined as a visible sign capable of distinguishing the origin or any other common characteristic including the quality of goods or services of different enterprises which use the sign under the control of a registered owner from the goods or services of any other enterprises. Sounds and smells are not currently eligible for trademark registration. Trade dress is not covered under the Trademarks Act, but remedies may be pursued for trade dress violations under either the Unfair Competition Act or the Industrial Designs Act.

Registration

What is Excluded from Trademark Registration?

A term is not registerable if:

- it is used only as a trade name;
- it is incapable of distinguishing the goods or services of one enterprise from the goods or services of another enterprise;
- it is contrary to public order or morality;
- it is likely to mislead the public or trade circles with particular reference to the geographical origin of the goods or services, their nature or characteristics;
- it is identical to or is an imitation of or contains as an element, an armorial bearing, flag, emblem, name, abbreviation or initials of the name, official sign or hallmark adopted by a state, an intergovernmental organization or organization created by an

international convention unless authorized by the competent authority of that state or organization;

- it is identical to or confusingly similar to or constitutes a translation of a trademark or trade name which is well known in Ghana for identical or similar goods or services of another enterprise;
- it is identical to or confusingly similar to or constitutes a translation of a trademark or trade name which is well known and registered in Ghana for goods or services that are not identical or similar to those under application but the use of the trademark will indicate a connection between those goods or services and the owner of the well known trademark and the interests of the owner of the well known trademark are likely to be damaged by the use of the trademark; or
- if the trademark is identical to a trademark of another owner already on the register or identical to a trademark the subject of an application with an earlier filing or priority date for the same goods or services or closely related goods or services or if it resembles that trademark so closely that it is likely to deceive or cause confusion.

Rights-holders applying for trademark registration should be aware that certain of the non-registerable elements (*e.g.*, emblems, flags) must be searched for manually as the government currently does not have a complete database. This may result not only in a delay in registration, but in registration of a trademark that may later on be subject to cancellation proceedings or to non-registration of a trademark.

Rights Conferred by Trademark Registration

Trademark law protects the rights-holder from other persons using the trademark in relation to the goods and services for which the trademark was registered without his or her agreement.

Under the Trademarks Act, the following constitutes an offense:

- Applying a false description to trade goods;
- Falsely applying to goods a trademark or mark so nearly resembling a trademark as to be likely to deceive;
- Forging a trademark;
- Using an article or instrument to forge a trademark;
- Possessing an article to forge a trademark;
- Causing the infringement of a mark; or
- Selling, exposing or possessing for sale or for any purpose of trade or manufacture goods or things to which a forged trademark or a false trade name description is

applied or to which a trademark or a mark so nearly resembling a trademark as to be likely to deceive is applied.

Forgery is defined for the purposes of the Trademarks Act as making a mark without the consent of the rights-holder or a mark so nearly resembling that mark as it would be likely to deceive or the falsification of a genuine trademark, whether by alteration, addition, effacement or otherwise. Burden of proof of consent is on the defendant. The Trademarks Act contains defenses for employees acting at the direction of another who were not interested in the goods for profit or commission or who had no reason as an employee to doubt the genuineness of the mark.

Registration

Set out below are the general steps for applying for trademark registration in Ghana. Applicants should be aware that databases for flags, emblems and similar are incomplete and that many searches are conducted manually. Collective marks follow much the same procedure but applications must indicate that the mark is a collective mark and include a copy of the regulations governing the use of the collective mark with the application. The steps set out below are those set out in the Trademarks Act, but should be confirmed with the Registrar-General's Department (RGD) upon application. Applicants should be aware that the regulations implementing the Trademarks Act have only recently been drafted and as of March 2011 had not yet been submitted to Parliament. Applicants may wish to inquire of local counsel as to the status of the current regulations. We recommend that you check the RGD website regularly for updates and current information. <http://rgd.gov.gh/>.

Step One: Obtain Qualified Counsel

If the ordinary principal residence or principle place of business of an applicant is outside of Ghana, the applicant must be represented by resident legal practitioners. Applicants are encouraged to seek out firms that have an attorney on staff with experience in Ghanaian IP law.

Step Two: Establish a Priority Claim

In the case of an applicant who is a citizen of a country who is a member to the Paris Convention or of the WTO, a priority declaration may be filed within six months from the date of first filing in the foreign country and should include a copy of the earlier application, certified as correct by the office with which it was filed.

Step Three: Prepare and Submit the Application

An application for the registration of a mark is filed with the RGD and shall be accompanied with a reproduction of the trademark and a list of the goods or services for which the registration of the trademark is requested using the classification according to the [Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of June 15th, 1957, as amended](#). The application shall

also include payment of the current application fee and declaration of priority, if applicable. The application may be withdrawn at any time.

Step Four: Examination and Publication

Upon submission, the RGD examines the application to determine whether or not the application meets the requirements of the Trademarks Act. Upon such determination, the application is published, and an interested person may file a notice of opposition to registration within two months on the grounds that either the mark is not a trademark as defined by the act or that the application is not complete. If an objection is filed, the RGD sends notice of the objection to the applicant, after which the applicant has an opportunity to file a counter-objection. The party making an objection or the original applicant may apply for an extension of time to file the notice of opposition or to prepare a response to opposition, if needed. If no counter-objection is filed, the application is deemed abandoned and registration is denied. If a counter-objection is filed, the RGD sends such counter-objection to the person who filed the notice of opposition and then decides on whether the trademark shall be registered after hearing both parties. Upon publication, an applicant has the same rights and privileges under the Trademarks Act until registration of the trademark as it would have had if the trademark had been registered.

Step Five: Granting Trademark Registration

If there is no objection during the publication period, the RGD issues the applicant a certificate of registration. A certificate of registration will also be issued where the RGD decides in favor of the applicant where the registration of a trademark was opposed upon publication. A decision by the RGD may be appealed to the High Court.

Filings Required in Change in Ownership and Licensing of Trademarks

Changes in ownership of a trademark or collective mark must be made in writing and must be filed with the RGD. A change in ownership is not valid if it is likely to cause confusion with regard to the nature, origin, manufacturing process, characteristics or suitability for the purpose of the goods or services to which the trademark or collective mark is applied. A change in ownership of a trade name must be in writing and addressed to the RGD when an enterprise is being transferred or when part of the enterprise identified by that name is being transferred.

Contractual licenses for trademarks must be submitted to the RGD, who will publish notice of such license. Terms and conditions of such license shall be kept confidential. A contractual license for a trademark is not valid against third parties until it has been filed with the RGD.

Enforcement Approaches

Criminal Enforcement

The Commercial Crime Unit (CCU) of the Criminal Investigation Department (CID) of the Ghana Police Service

For infringing goods that are suspected of having been produced in Ghana or have been imported into Ghana, rights-holders may approach the Commercial Crime Unit (CCU) of the Criminal Investigation Department (CID) of the Ghana Police Service.

The majority of the CCU's investigations into IP violations originate from tips from either rights-holders or from informants. Under Ghanaian law, there is a reward for information that leads to the discovery of infringing goods and conviction of the infringer; certain enterprising individuals make their living as professional informants. Upon receiving a tip about infringing goods, the CCU will investigate and upon confirmation that the goods are infringing, is empowered to seize the infringing goods and to arrest any persons in possession of infringing goods. The CCU may allow rights-holders to participate in raids.

The Preventive Unit of CID has a Rapid Response Unit (RRU) that has the capacity to prevent the often quick dissemination of infringing goods. The RRU is used when it is known to a high degree of certainty the location and means by which a shipment of infringing goods or otherwise illicit products are entering the country. A court order is usually required before the RRU will investigate possible IPR violations.

Criminal Prosecution

The Criminal Code 1960 (Code) defines a list of types of fraud, including intellectual property fraud. While most often IP fraud is prosecuted under the relevant IP law, upon occasion a charge may be brought under the Code for fraud or fraudulent representation, if the authorities deem it more relevant. If charges are brought under the Code rather than under IPR laws, a rights-holder may elect to pursue damages under the Unfair Competition Act. Anyone found guilty of infringement under the Trademarks Act may be sentenced to a maximum of one year imprisonment.

Criminal prosecution can better deter violators from repeating their crimes. Many individuals may commit intellectual property crimes not only because they can be relatively easy to commit, but also because the perpetrators believe that they will not be prosecuted. Criminal prosecution plays an important role in establishing public expectations of right and wrong, and in educating the public about intellectual property rights. If you believe that you are a victim of intellectual property theft, we recommend that you document all investigative steps, preserve evidence and contact the relevant authorities right away. Intellectual property crimes may be reported to the relevant offices (e.g., the RGD) and to either the Customs Division of Ghana Revenue Authority, Chief Collector, Preventative OPS - Headquarters (for import and export of counterfeits) at +233 (0)302 686106/684363 or +233 (0)244 364 642 or via email at pr@ghanacustoms.gov.gh or the CCU at +233 (0)302 76 17 34.

You may also submit a tip through the Ghana Police Service website at <http://www.ghanapolice.info/>

Administrative Enforcement

Invalidation of Mark

Any interested party may request invalidation of a trademark on the following grounds:

- The mark in question does not meet the definition of a trademark under the Trademarks Act;
- The owner of the mark did not satisfy the requirements of registration under the Trademarks Act; or
- Due to the actions or inactivity of the rights-holder, the mark in question has become synonymous with a type of product, rather than as a means to identify and distinguish the source of the goods or services for which it was registered ("generic").

Invalidation is effective from the date of registration of the mark. The RGD records the invalidation and publishes notice of invalidation. Burden of proof is on the person requesting invalidation.

Invalidation of Collective Marks

A rights-holder or other interested party may request invalidation of a collective mark on the following grounds:

- Only the registered owner uses the trademark to the exclusion of any other enterprises;
- The registered owner permits the use of the trademark in contravention of the regulations of the collective mark; or

- The registered owner uses or permits the use of the trademark in a manner likely to deceive trade circles or the public as to the origin or any other common characteristics of the goods or services concerned.

Burden of proof is on the person requesting invalidation.

Removal of Trademark from Register for Non-use (Abandonment)

An interested person may request that the RGD remove a trademark from the register for non-use if, one month prior to filing for removal, the interested party provides evidence that the trademark had not been used by the registered owner or a licensee for any of the goods or services in respect of which it was registered for a continuous period of five years or longer. The trademark will not be removed from the register upon a showing that special circumstances prevented the use of the trademark and that there was no intent to abandon the mark.

Cancellation of Trademark under the Geographical Indications Act, 2003 (Act 659)

The RGD, on its own or on the motion of an interested party, shall refuse or cancel a registration of a trademark which contains or consists of a geographical indication (GI) with respect to goods not originating in the territory indicated, if the use of the GI in the trademark misleads or is likely to mislead the public as to the true place of origin of the goods. For more information, see the section entitled "GEOGRAPHICAL INDICATIONS – Enforcement Approaches – *Administrative Enforcement – Cancellation of Trademark*" in this Toolkit.

Administrative Proceedings Before the RGD

A rights-holder or interested party may file a claim for relief with the RGD. Evidence is given by statutory declaration, or the RGD may take evidence on oath instead of or in addition to a statutory declaration. The RGD has the same powers under the Trademarks Act with the respect to compulsion of witnesses, the production of a document and the taking of evidence on oath as the High Court, and witnesses before the RGD are entitled to the same immunities and privileges as if appearing as a witness before the High Court. The RGD may award costs and direct how and by which of the parties they are to be paid and any order for costs may, by leave of the High Court, be enforced as a judgment or order of the High Court. If a rights-holder has an option to proceed before the RGD or the High Court, the RGD may refer the application to the High Court at any stage of proceedings. If there is already an action concerning the trademark in question before the High Court, the application shall be made to the High Court instead of the RGD.

The Customs Division of Ghana Revenue Authority (Customs)

Another agency that rights-holders may approach for assistance in combating trademark infringement is the Customs Division of Ghana Revenue Authority (formerly known as the Customs, Excise and Preventive Service (CEPS)) (Customs).

Businesses exporting products that carry a high risk of being counterfeited are encouraged to work directly with Customs. The Preventive Department within Customs is chiefly responsible for blocking infringing goods and otherwise illicit material from entering the country. Businesses that export high risk products should supply the Preventive Department of Customs with a detailed description and sample of their product.

Infringing goods are known to enter Ghana from its ports and multiple borders. Customs recommends that if a rights-holder believes that counterfeits of its products are entering the country from multiple entry points that the rights-holder hold an informational workshop. Customs officers from around the country attend workshops in which producers and rights-holders describe and supply prototype authentic and counterfeit goods. The more detailed the information and training provided by the rights-holder, the more likely Customs officers are to stop infringing goods at the ports and borders.

If a Customs agent believes that a shipment of products contains infringing goods, the agent can stop the shipment at the border. When infringing goods have entered the country and are being warehoused, distributed or retailed, Customs officers are authorized to enter a warehouse, factory or store and take an account of the excisable goods in the custody or possession of the seller. Customs officers are further authorized to take samples of goods suspected of being infringing, to the extent that the usual price of goods is paid. When the Commissioner of the Customs Division of Ghana Revenue Authority (Commissioner) is satisfied by information and samples that there is reasonable cause to suspect that infringing goods are harbored, kept, or concealed in any premises, the Commissioner may issue a written order authorizing an officer to enter and search the premises, and to seize and take away any of the infringing goods. In addition to seizure of any infringing goods, Customs officers may also arrest any person in whose possession and under whose control the infringing goods are found.

The law provides for a reward for any person whose "tip-off" leads to the confiscation of counterfeit goods and the arrest of anyone dealing in counterfeits. Customs regularly benefits from tip-offs, from private citizens in addition to receiving information from rights-holders and discovery of infringing goods by members of the Customs units themselves.

Rights-holders with the requisite evidence may submit a written request of detention to Customs independent of any Customs investigation or action. The request must provide evidence that demonstrates a high likelihood that infringement is occurring and that injunctive action is necessary to avoid further damage; such request may or may not require a court order. Rights-holders should also provide evidence of ownership of the mark. According to the Trademarks Act, the request must include the following information:

- The number of packages expected;
- A description of the goods by marks or any other particulars sufficient for identification;

- Details of the means of conveyance and expected date of arrival of the goods in the country;
- The reasons for which the detention is requested; and
- Any other information the Commissioner may require.

The Trademarks Act also indicates that the rights-holder must also deposit with the Commissioner a sum of money that the Commissioner may require to cover expenses which may be incurred in the examination of the goods. In addition to this deposit, the Commissioner *may* require security from the rights-holder to recover expenses, charges, costs and damages incurred in respect of the detention and subsequent proceedings. Rights-holders should note, however, that although the law specifies a charge or deposit, it is rarely required or enforced, especially in situations where the person filing the complaint is an uncontested rights-holder.

In discussions, Customs officers indicated that a bond is normally only required in situations where the goods themselves are “gray market”, that is, authentic, but sold outside an authorized sales territory or by an unauthorized dealer in an authorized sales territory. Under these circumstances, the goods are impounded and a bond paid until the parties have reached an agreement on the goods or a court has determined the outcome of the dispute.

Upon occasion, Customs will allow rights-holders more direct participation beyond informing the Preventive Department that infringement is occurring. In order for a rights-holder to participate more directly in Customs anti-counterfeiting investigations and procedures, Customs requires the producer to demonstrate in writing reasonable grounds for suspecting that counterfeits of its products are entering or being sold within the country.

It is recommended that rights-holders pay a courtesy call to Customs officials upon entering the Ghanaian market, provide Customs with copies of originals and hints on how to spot counterfeits and to establish a relationship with Customs on an ongoing basis, providing information, intelligence and training and support. Face-to-face interaction with enforcement officials may be a more effective means of communication than phone or email.

The Ghana Standards Board (GSB)

The Ghana Standards Board (GSB), operates under the Standards Authority Act, 1973 and the subsequent Labeling Rules Amendment of 1992 within the Ministry of Trade and Industry. The GSB develops and promulgates the standards by which all manufactured and imported products must comply. The GSB is further charged with ensuring that all products that enter the country comply with its standards. The GSB Destination Inspection Department (DID) and the GSB’s Market Surveillance Group (Market Surveillance Group) monitor and enforce the BSB’s mandate of protection of the Ghanaian population. The GSB actively collaborates with Customs, the Food and Drug Board (FDB) and other regulatory bodies in its inspection, testing, and monitoring activities.

All shipments of goods arriving at Ghana entry points are inspected by the DID and contracted inspection companies. The DID randomly samples shipments for quality testing; upon passing these initial tests products are forwarded to Customs for further inspection and clearance. Certain products that are classified as high risk goods (HRGs) must be duly registered with the GSB prior to importing into Ghana. For a list of HRGs, go to <http://www.gsb.gov.gh/site/home>. Additionally, the GSB regularly deploys the Market Surveillance Group to inspect products being sold to the public and ensure that they are in compliance with the requisite standards. The GSB will inspect and sample non-health related goods at the entry points, and if those goods are found to be counterfeit at the inspection and sampling stage, the GSB has the authority to seize them. The Market Surveillance Group, however, typically reserves investigation and seizure actions for goods that are health-related. For non-health related goods, Customs may offer more effective market protection.

The GSB encourages stakeholders to work closely with the DID and Market Surveillance Group to ensure that counterfeits of their products do not reach the Ghanaian population. The GSB requires all products to be labeled with the following:

- Name of the product;
- List of the components or ingredients;
- For drugs, a list of active ingredients and their levels in drugs;
- Date of manufacture and expiry date;
- Storage conditions;
- Instruction or directions for use;
- Net content;
- Name and address of the manufacturer;
- Country of origin;
- Date of manufacture;
- Batch/Lot number; and
- Electro-technical or chemical characteristics for goods.

Rights-holders that wish to give their product greater protection may notify the DID of the additional protection measures. The GSB recommends that additional protection measure notifications be made in writing and accompany a sample of the product. These notifications should list the product's distinctive characteristics and include pictures in which the distinguishing characteristics are highlighted and described. In the past, these additional measures have included the specific weight and dimensions of the product, holographic instruments and validating serial number series.

Rights-holders that import numerous products may find it cost-effective to host educational workshops at the GSB's headquarters. This is a common practice and can work to sensitize and educate the GSB, the DID, the Market Surveillance Group and importers to the current practices of counterfeiters and the potential harms arising from importation of infringing or passed-off products.

The GSB encourages rights-holder participation in investigative actions. Prior to taking part in an investigation, rights-holders must first demonstrate that they are legally vested in a right that is being infringed, which may or may not require a court order. Rights-holders must demonstrate that they are legally vested in the trademark appearing on the allegedly passed off or infringing goods and that it is reasonably likely the product will be held in violation of the applicable IP law.

While any IP infringement falls within the GSB's jurisdiction, the GSB's chief mandate is to protect the well-being of the Ghanaian population. In light of this concern, products that do not implicate the health of the population, in practice, are not considered to fall within the GSB's jurisdiction once investigation or enforcement is necessary.

If a rights-holder has specific knowledge of a shipment of infringing goods and their targeted entry point, the rights-holder should contact both the DID and Customs. The GSB does not have a rapid response unit, but DID agents cover every legal entry point. They have the power to seize and detain any individuals involved until the police service is able to respond. By contacting both the GSB and Customs, rights-holders are able to use either office as a check on the other and to ensure a wider range of coverage.

The GSB may prohibit the sale and distribution of goods that have not been certified by the GSB as well as those products that do not meet the standards set by the GSB. The GSB is obligated to cooperate with any international or domestic organization that is acting in furtherance of the functions of the GSB so long as those organizations are seeking the GSB's cooperation.

Under the Ghana Standards Board General Labeling Rules 1992 Amendment to the 1973 Standards Authority Act, the GSB, in consultation with the secretary, has appointed inspectors to participate in the activities of the Market Surveillance Group. Inspectors' enforcement and investigative actions must be authorized by the Director. Upon authorization, an inspector may at all reasonable times enter any premises or place where the inspector has cause to believe that infringing goods are being offered for sale, distributed, or disposed of. The inspector may examine the products to ascertain whether they conform to the provisions of the 1992 Amendment's rules and regulations. Inspectors may seize any products which are determined to be counterfeit or products that have been labeled in such a way as to be deceptive, misleading, or false. In practice, the Market Surveillance Group relies on stakeholders to alert them to infringement, the first step in initiating an investigation.

The Food and Drug Board (FDB)

Trademark rights-holders may also be able to work with FDB or the Pharmacy Council if the allegedly infringing goods are food or health-related. In addition to prosecution under the Trademarks Act, Infringing parties may also be prosecuted criminally under the Food and Drugs Law, Criminal Code 1960 (Act 29), Section 161, Act 664, and Act 657. While such methods of redress have relative success, the process is currently challenged by delays. Unfortunately, infringing parties often deal in fast moving consumer goods. To counter this trend, the FDB – in conjunction with the High Court – offers expedited injunctive relief. For allegedly counterfeit or passed off products, court orders of seizure or forfeiture are granted when rights-holders can demonstrate that they are legally vested in the right in question and that the allegedly infringed right is reasonably likely to be in violation of the relevant legislation. When the products in question are clearly infringing, the FDB is authorized to seize and arrest, upon the authorization of the director of the FDB.

During an investigation of infringing or passed off goods, FDB officers and officers of the Drugs Post-Market Surveillance Unit (Drug Surveillance Unit) are authorized to enter any premises where they believe counterfeits are being prepared, preserved, packed, stored, or conveyed. Officers may examine and take for samples any product suspected of being in violation of the Food and Drugs Law, Act 29, or Act 589.

The Drug Surveillance Unit is most successful in monitoring and closing unlicensed pharmaceutical sellers. These typically are pharmacy stalls in markets that do not employ licensed pharmacists and do not adhere to the regulations promulgated by the Ghana Pharmacy Council (Pharmacy Council). These stalls often sell unregistered and infringing goods among other products, and thus their closing down assists in protecting IPR. However, the Drug Surveillance Unit is also responsible for the monitoring of products on pharmacy and licensed chemical seller shelves. As of 2009, there were 1,400 pharmacies and 10,106 licensed chemical sellers. There simply are too many pharmacies and licensed chemical sellers for the Drug Surveillance Unit to be able to effectively monitor each individual outlet.

Rights-holders can play a key role in alerting the FDB to specific products that are either at a high risk of infringement or are reasonably suspected of having been counterfeited. Alerting the FDB to specific problem sites and products helps to focus their monitoring procedures. However, to begin fully collaborating with the FDB and Drug Surveillance Unit on a specific investigation, rights-holders must demonstrate that they are legally vested in a right that is reasonably suspected of being infringed, which may or may not require a court order. If a court order is necessary, rights-holders must demonstrate that they are legally vested in the mark that appears on the allegedly passed off or infringing goods and that it is reasonably likely the product will be held in violation of the applicable IP law.

Upon a showing that a rights-holder's rights are reasonably suspected of being infringed, authorized rights-holders may actively contribute to investigative actions taken by the Drug Surveillance Unit. Upon the authorization of the Director of the FDB or a court order, the products in question can be seized by the FDB, recalled by the Pharmacy Council and the

offending parties may be arrested. The media is typically alerted of the potential health implications of the goods. If the seized goods are found to be in violation of the law they will be destroyed.

The Ministry of Trade and Industry is developing a system by which the duties of the GSB and FDB can be effectively distinguished, however, rights-holders whose products currently fall within their shared jurisdiction must deal with both the GSB and FDB to encourage collaboration on the rights-holder's behalf.

The Ghana Pharmacy Council

The Pharmacy Council works closely with the FDB on many drug-related issues, including the passing off of pharmaceuticals. Rights-holders may proactively take advantage of the Pharmacy Council's recall capacity. Upon notification of a recall from the Pharmacy Council, many pharmacists will purge their inventory of any detected counterfeits to avoid facing charges. This process damages law-abiding pharmacists' profits; thus, pharmacists have a direct incentive to prevent infringing products from making it onto their shelves. Rights-holders that believe that their products have been counterfeited and distributed, or are at a high risk of infringement, have carried out successful pharmacy awareness campaigns. These campaigns often notify pharmacists with detailed descriptions and pictures of their authentic product, highlighting the distinguishing aspects of their trade dress as compared to possible infringing and passed off products.

Both the FDB and the Pharmacy Council conduct training programs for their officers and pharmacists. Rights-holder participation in these training programs is encouraged. Training programs directed at increasing awareness of current passing off and counterfeit trends can have a significant impact as current understanding and awareness is low.

Civil Enforcement

Civil Litigation

At the request of the rights-holder, the High Court may grant an injunction to prevent infringement or imminent infringement, award damages and grant any other relief provided for in the general law. There are three types of High courts in Ghana: the standard High Courts, the "fast track" High Courts and the commercial High Courts. While each offers its own advantages, judges on the commercial courts tend to be more IP-savvy, many having completed IP training. Under the rules of civil procedure, the High Court may grant an award of damages to a rights-holder if it is determined that infringement has occurred. Burden of proof for an award of damages is on the rights-holder, and the amount of damages is determined by the High Court.

The chief advantage of pursuing IPR claims in civil litigation is that unlike criminal proceedings, they may be initiated directly by the rights-holder. Due to administrative backlogs, the High Court may also offer a shorter path to resolution than administrative procedures before the RGD. The High Court may direct the RGD to appear in proceedings before the court, but the RGD shall not be awarded costs or ordered to pay costs to any

other party. The RGD is a party to proceedings in which the relief sought would affect the register. Rights-holders are advised to engage local counsel experienced in IPR issues in the event of any litigation.

Other Measures

NGOs and Professional Organizations

Several non-governmental organizations in Ghana play important roles in helping enforce IPR, including participating in public information campaigns, reporting suspected infringements and training government personnel. Rights-holders are encouraged to seek out such NGOs for information and support. These organizations include:

- Business Coalition Against Counterfeiting and Illicit Trade (CACIT)
<http://bcacit.com/home/index.php>
- Ghana Employers' Association (GEA)
<http://www.ghanaemployers.com/>
- Institute of Packaging Ghana
<http://www.iopg.org.gh/>
- The Association of Ghanaian Industries
<http://www.agighana.org/>
- The Consumers' Association of Ghana
Tel: +233 (0)302 784461; +233 (0)302 238042

Rights-holders may find it useful to work with one or more of these organizations in protecting their IPR.

Public Information Campaigns

In general, public awareness in Ghana is the cornerstone of a successful IPR protection plan. Upon detection of infringing goods entering the Ghanaian market, rights-holders have informed the public of the illegal nature of infringing goods, with varying degrees of success. In the past, public relations campaigns have resulted in the return of a portion of the infringing goods that have infiltrated legitimate retail businesses. Rights-holders may also contact relevant agencies and offer training in differentiating authentic versus infringing products to those individuals charged with search and seizure.

With respect to pharmaceuticals, the International Policy Network estimates that between 30 percent and 50 percent of all drugs sold on the Ghanaian market are substandard or counterfeit. The inferior counterfeiting measures used to deceive unsuspecting consumers in Ghana can often be detected through a cursory inspection of the products' trade dress. Public relations campaigns that improve awareness of the prevalence and dangers of infringing goods – as well as the methods by which they may be detected – can sensitize the media and public and increase the number of publicly reported cases. Successful public

awareness campaigns with respect to health-related products or pharmaceuticals have collaborated with the FDB.

FAQ

1. Must I register my trademark in order to claim trademark protection in Ghana?

Yes. While certain well-known trademarks may be grounds for denial of a false trademark registration, in order to bring a claim for infringement or effectively enforce rights otherwise, registration is necessary.

2. If I want to register my trademark in Ghana, where do I go?

Registration is made with the Registrar-General's Department. You may contact them outside of Ghana at +233 (0)302 664 691-93 or visit their website at <http://rgd.gov.gh/>.

3. What is the duration of trademark protection in Ghana?

The registration of a trademark is valid for a period of ten years from the filing date of the application for registration. The registration may be renewed for consecutive periods of ten years on payment of a renewal fee, and as long as the fees are paid the trademark can exist in perpetuity, provided that it is still in use in the Republic of Ghana.

4. Where should a trademark owner file a complaint alleging trademark infringement?

A rights-holder may file a complaint with either the RGD or with the High Court. A rights-holder has the option to proceed before the RGD or the High Court; the RGD may refer the application to the High Court at any stage of proceedings. If there is already an action concerning the trademark in question before the High Court, the application shall be made to the High Court instead of the RGD.

5. If I file with the RGD instead of the High Court, can I be awarded damages?

Yes. The RGD may award costs and direct how and by which of the parties they are to be paid and any order for costs may, by leave of the High Court, be enforced as a judgment or order of the High Court.

6. What are the penalties in Ghana for trademark infringement?

Violations under the Trademarks Act are punishable by a fine not exceeding 500 penalty units (currently a penalty unit is equal to GHC 12.00; the current maximum fine would be GHC 6,000.00) or to one year imprisonment or both.

7. How long can I wait until filing a claim for relief?

As with any IP right, it is advised that you file a claim as soon as possible. A prosecution under the Trademarks Act must commence either three years from

commission of the offense or one year after first discovery of the offense by the prosecutor, whichever occurs first.

We strongly emphasize that the information provided in this Toolkit does not constitute legal advice and should not be a substitute for advice of legal counsel. Its intended purpose is to provide an overview of Ghana's IPR environment, available enforcement mechanisms and Ghanaian government offices sharing jurisdiction over IPR protection and enforcement. We recommend that U.S. companies seeking to do business in Ghana or facing IPR infringement issues in Ghana seek qualified U.S. and/or Ghanaian legal counsel in pursuing their rights through Ghana's IPR enforcement regime. The U.S. Government, the U.S. Department of State, the U.S. Department of Commerce, their employees and contractors assume no legal liability for the accuracy or completeness or usefulness of any information, resource or process contained disclosed herein.